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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,334	11/09/2001	Hidekazu Nakai	450100-03694	5902
20999	7590	02/08/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			SCUDERI, PHILIP S	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,334

Applicant(s)

NAKAI, HIDEKAZU

Examiner

Philip S. Scuderi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokono et al. (US 6,529,946, hereinafter "Yokono") in view of Hosoe (US 6,047,376).

3. With respect to claim 1, Yokono discloses a recording medium (figures (8, 12, and 22) #90, fig. 6, col. 13 lines 33-41), having a second storage region into which data can be written (col. 13 lines 36-41). Yokono discloses a means for establishing a connection to a predetermined server over a predetermined network and downloading data from the connected server (col. 6 lines 43-52). However, Yokono does not disclose that said means is embodied on a first storage region of the recording medium.

Nonetheless, a memory medium having a first storage region in which program information describing a procedure for executing a process for establishing a connection to a predetermined server over a predetermined communication network and downloading data from the connected server is stored was well known, as evidenced by Hosoe. In a similar art, Hosoe discloses a memory medium (fig. 2 #35) having a first storage region in which program information describing a procedure for executing a process for establishing a connection to a predetermined server is stored (fig. 2 "Server Access Authentication Program", col. 4 lines 36-37, fig. 2 "Server Address", col. 1 lines

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52-54). Given the teachings of Hosoe it would have been obvious to one of ordinary skill in the art to adapt the recording medium taught by Yokono to comprise a first storage region in which program information describing a procedure for executing a process for establishing a connection to the predetermined server over the predetermined communication network and downloading data from the connected server is stored. The motivation for doing so would have been to provide a means for reading out the server address and memory medium identification information (Hosoe col. 3 lines 49-51).

4. With respect to claim 2, Yokono in view of Hosoe teaches the recording medium applied to claim 1. Yokono further discloses a third storage region having an ID unique to said recording medium stored therein (fig. 8 "Medium ID", col. 15 lines 12-17).

5. With respect to claim 3, Yokono in view of Hosoe teaches the recording medium applied to claim 2. Yokono does not disclose that the ID is information which can be utilized by said server to manage accounting for the downloaded data. However, Hosoe further discloses a third storage region having an ID unique to the memory medium (fig. 2 "Memory Medium Identification Number (N)"). Hosoe discloses that said ID is used to identify the medium at logon (col. 5 lines 24-31) and that the ID is information which can be utilized by a server to manage accounting for downloaded data (col. 2 lines 51-67).

Given the further teachings of Hosoe it would have been obvious to one of ordinary skill in the art to use the ID to manage accounting for the downloaded data. The motivation for doing so would have been so that only clients having a legal memory medium are given access permission (Hosoe col. 2 lines 65-67).

6. With respect to claim 4, Yokono in view of Hosoe teaches the recording medium applied to claim 2. Hosoe further discloses a third storage region having an ID unique to

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the memory medium (fig. 2 “Memory Medium Identification Number (N)”). Hosoe discloses that said ID is used to identify the medium at logon (col. 5 lines 24-31) and that the ID can be utilized by the server to identify a type of the download data (fig. 9 #S35, col. 7 line 65 – col. 8 line 1). Given the further teachings of Hosoe it would have been obvious to one of ordinary skill in the art to adapt the server to utilize the ID to identify a type of the download data. The motivation for doing so would have been to identify and provide the necessary service (Hosoe col. 7 lines 52-54).

7. With respect to claim 5, Yokono in view of Hosoe teaches the recording medium applied to claim 2. Hosoe further discloses a third storage region having an ID unique to the memory medium (fig. 2 “Memory Medium Identification Number (N)”). Hosoe discloses that said ID is used to identify the medium at logon (col. 5 lines 24-31) and that the ID can be utilized by the server to identify a supply source of the download data (fig. 9 #S35, col. 7 line 65 – col. 8 line 1). Given the further teachings of Hosoe it would have been obvious to one of ordinary skill in the art to adapt the server to utilize the ID to identify a supply source of the download data. The motivation for doing so would have been to identify and provide the necessary service (Hosoe col. 7 lines 52-54).

8. With respect to claim 6, Yokono discloses a downloading method, comprising:

- a means for establishing a connection to a predetermined server over a predetermined communication network, downloading data from the connected server (col. 6 lines 43-52), and storing said data on a second storage region of a storage medium (col. 13 lines 36-41); and
- a storage control step of storing the data acquired by the downloading into said second storage area of said storage medium (col. 6 line 66 – col. 7 line 8).

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Yokono does not disclose that said means comprises the recording medium having a first storage region in which program information describing a procedure for executing a process for establishing a connection to the predetermined server over the predetermined communication network. Nonetheless, a memory medium having a first storage region in which program information describing a procedure for executing a process for establishing a connection to a predetermined server over a predetermined communication network is well known, as evidenced by Hosoe. In a similar art, Hosoe discloses a memory medium (fig. 2 #35) having a first storage region (fig. 2 "Server Access Authentication Program", col. 4 lines 36-37) in which program information describing a procedure for executing a process for establishing a connection to a predetermined server (fig. 2 "Server Address", col. 1 lines 52-54) over a predetermined communication network (fig. 2 #100) is stored. Given the teachings of Hosoe it would have been obvious to one of ordinary skill in the art to adapt the recording medium taught by Yokono to comprise a first storage medium in which program information describing a procedure for executing a process for establishing a connection to the predetermined server over the predetermined communication network and downloading data from the connected server is stored. The motivation for doing so would have been to provide a means for reading out the server address and memory medium identification information (Hosoe col. 3 lines 49-51). Hosoe further discloses an access step of accessing a server in accordance with the read out program information (fig. 3 #S1-S10). Given the further teachings of Hosoe it would have been obvious to one of ordinary skill in the art to access the server in accordance with the read out program information because, as discussed above, the program information comprises information for connecting to the server. Yokono further

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discloses a download step of downloading required data from the server (col. 6 line 66 – col. 7 line 8). Therefore it would have been obvious to one of ordinary skill in the art to include a download step of downloading required data from the server accessed in accordance with the read out program information discussed above.

Conclusion

9. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Sato et al. (US Pub. 2002/0055969);
- Srinivasan (US Pub. 2002/0062357);
- Hosoe (US 6,553,492); and
- Srinivasan (US 6,460,076).


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 8am-5pm.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PSS



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